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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	:	Castleman
For	:	Methods and Apparatus for Developing and Marketing Combined Insurance Packages
Serial No.	:	10/714,281
Filed	:	11/14/2003
Group	:	3626
Examiner	:	Lubin, Valerie

Durham, North Carolina
August 11, 2010

MAIL STOP APPEAL BRIEF – PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' BRIEF

Sir:

1. The Real Party In Interest

The real party in interest is the assignee, Genworth Mortgage Holdings, LLC.

2. Related Appeals and Interferences

None.

3. Status of the Claims

This is an appeal from the March 17, 2010 final Official Action rejecting claims 5-24, all of the pending claims.

Claims 1-4 have been canceled.

Claims 5-24 are the subject of this appeal.

4. Status of Amendments

The claims stand as amended on December 21, 2009.

5. Summary of Claimed Subject Matter

Aspects of the present invention address computer implemented systems, computer based methods, and a computer readable medium for assembling and marketing insurance packages. These packages combine a mortgage insurance component and at least one additional insurance component having an effect on the risk of the mortgage insurance component. The cost of the mortgage insurance is adjusted in light of the effect of the risk. One example is the job loss insurance of claims 10-13 and 20-24. As recognized by the inventors, because job loss insurance may reduce the risk of the mortgage insurance, a computed cost for the mortgage insurance may be reduced utilizing a risk evaluator as claimed in claims 21-24, for example.

Claim 5

Turning to the specifics of the claims, claim 5 addresses a "computer implemented system for assembling and marketing insurance packages including a combination of a mortgage insurance component having a risk when sold separately and at least one additional insurance component having an effect on the risk of the mortgage insurance component when sold together with the mortgage insurance component" as illustrated generally in Figs. 1-7 and described at p. 5, line 17 et seq.

The computer implemented system, such as server 202 of Fig. 2, comprises "long term storage hosting a risk data repository for storing risk information to be used in determining the risk and cost of providing insurance packages", such as long term storage 208 of Fig. 2, described at p. 7, lines 10-15, for example.

The long term storage further hosts "an insurance data repository including information about one or more available additional insurance components, the repository including information about the mortgage insurance component and the one or more additional insurance components", such as data repository 26 of Fig. 2, described at p. 7, line 15-p. 8, line 6, for example.

The computer implemented system further comprises "a risk evaluator implemented as a software module hosted by the computer and executed under control of a processor to determine risks and costs associated with providing insurance, the risk evaluator operating to compute overall risk and cost for a combined package and adjust parameters of the package components including adjusting the cost of the mortgage insurance component in light of the effect on said risk of the at least one additional component to optimize the risk and cost of the package", such as the risk evaluation module 216 of Fig. 2, and described at p. 8, line 14-p. 10, line 8, for example.

Claim 6

Claim 6 depends from claim 5 and further includes "a package terms development module for receiving desired criteria for an insurance package and developing a set of terms meeting those criteria and wherein the package terms development module passes the desired criteria to the risk evaluator and the risk evaluator produces optimized risk and cost information for a package meeting the desired criteria", such as package terms development module 218 of

Fig. 2, and described at p. 10, line 9-p. 11, line 2; and also p. 16, lines 7-14, for example.

Claim 7

Claim 7 depends from claim 2 and further comprises "an operator interface module allowing submission of criteria to be used in developing insurance packages to be made available and wherein terms meeting the criteria are presented to an operator using the operator interface module, such as operator computer 222 of Fig. 2, described at p. 11, lines 3-9; and operator interface module 226 of Fig. 2 described at p. 11, line 23-p. 12, line 4.

Claim 8

Claim 8 depends from claim 7 and further comprises "a consumer interface module allowing submission by a consumer of criteria for a specific insurance package and wherein terms meeting the criteria are presented to the consumer using the consumer interface module", such as consumer computer 224 of Fig. 2, described at p. 11, lines 10-18 and p. 17, lines 1-12; and consumer interface module 228 of Fig. 2, described at p. 11, lines 23-p. 12, line 9.

Claim 9

Claim 9 depends from claim 8 and further includes a package negotiation module operative to receive an indication from a consumer to commit to coverage and to assemble and store details of the coverage package and the commitment for coverage", such as package negotiation module 228 of Fig. 3, described at p. 11, line 23-p. 12, line 9.

Claim 10

Claim 10 depends from claim 9 and recites "wherein the insurance packages assembled and marketed include a combination of mortgage insurance and job loss insurance, and wherein the additional insurance components whose information is stored in the insurance data repository include job loss components", as described at p. 6, lines 9-14, and p. 7, line 15-p. 8, line 6, for

example.

Claim 11

Claim 11 depends from claim 10 and recites "wherein the package terms development module, the operating interface module, the customer interface module, and the package negotiation module are implemented in the form of software hosted on the computer implemented system executed under control of the processor", as described at p. 7, lines 14 and 15; p. 13, line 22-p. 14, line 3.

Claim 12

Claim 12 depends from claim 11 and recites "wherein the computer implemented system receives inquiries and commands from external computers over a publicly accessible network and transfers information to the external computers over the publicly accessible network", such as consumer computer 224, described at p. 11, lines 10-18, for example.

Claim 13

Claim 13 depends from claim 12 and recites "wherein the publicly accessible network is the Internet" as described at p. 11, line 19, for example.

Claim 14

Claim 14 addresses a "computer based method of developing and marketing combined packages of insurance including mortgage insurance and job loss insurance", as illustrated generally in Figs. 1-7 and descried at p. 5, line 17 et seq. and more particularly with respect to aspects of Fig. 7, described at p. 20, line 11-p. 22, line 23, for example.

The method comprises "collecting and storing data related to risks and costs of providing insurance in a data repository hosted in long term storage"

The method comprises "developing utilizing a processor executing software details of

insurance components in long term storage, said components to be made available in the form of combined packages, the packages including a mortgage insurance component and a job loss insurance component" such as step 708 Fig. 7, as described at p. 21, lies 13-20; and the discussion of the operation of system 200 of Fig. 2.

The method comprises "storing said details" as described at p. 12, lines 16 and 17; and p. 13, lines 8 and 9, for example.

The method comprises "evaluating risks and costs associated with providing a package of insurance including mortgage insurance and job loss insurance employing a risk evaluator implemented as a software module executed under control of the processor, evaluation comprising evaluating each component of the package, and evaluating the combined risk and cost of the package as a whole", such as step 710, described at p. 21, line 20-p. 22, line 3, for example.

The method comprises "adjusting parameters of the package to optimize the risk and cost of the package utilizing an optimization module implemented as a software module executed under control of the processor", such as step 712 as described at p. 22, lines 4-10, for example.

Claim 15

Claim 15 depends from claim 14 and further includes "receiving a set of criteria for an insurance package, and computing optimized risk and cost information to develop an optimized set of cost information and package parameters for a package meeting the criteria" as described at p. 11, lines 3-18; and p. 16, lines 8-14, for example.

Claim 16

Claim 16 depends from claim 15 defining the step of receiving the set of criteria to comprise "receiving a set of criteria for an insurance package required by a consumer and further

comprising a step of providing the consumer with cost information and package parameters for a package meeting the criteria" as described at p. 17, lines 1-12, for example.

Claim 17

Claim 17 depends from claim 16 reciting "wherein the step of receiving a set of criteria for an insurance package includes receiving the criteria as electronic data transferred over a computer network and the step of computing optimized risk and cost information includes retrieving risk and cost information stored in an electronic database and performing electronic data processing on the criteria for the insurance package and on the risk and cost information to develop an optimized set of parameters for the insurance package" as described at p. 11, lines 3-18; and p. 16, lines 8-14, for example.

Claim 18

Claim 18 depends from claim 17 further defining the step of receiving the set of criteria for an insurance package to include "presenting hypertext forms for display on a customer computer and receiving a submission of information entered using the hypertext forms", as described at p. 17, lines 1-4, for example.

Claim 19

Claim 19 addresses a "computer readable medium storing a software program" as described in connection with the operation of system 200 of Fig. 2 to perform the methods of Figs. 1 and 7, for example; as well as, original claim 19.

When the software program is executed on a computer they cooperate to "receive and store data related to risks and costs of providing insurance" as addressed above in connection with the first method step of claim 14.

When the software program is executed on a computer they cooperate to "store details of

insurance components to be made available in the form of combined packages, the packages including a mortgage insurance component and a job loss insurance component" as addressed above in connection with the second method step of claim 14.

When the software program is executed on a computer they cooperate to "evaluate risks and costs associated with providing a package of insurance including mortgage insurance and job loss insurance, evaluation comprising evaluating each component of the package, evaluating the combined risk and cost of the package as a whole and adjusting parameters of the package to optimize the risk and cost of the package" as addressed above in connection with the third and fourth method steps of claim 14.

Claim 20

Claim 20 depends from claim 5 and further recites "wherein the combined package comprises a job loss component having a cost" as described at page 5, line 7-p. 7, line 9; and p. 9, lines 14 and 15, for example.

Claim 21

Claim 21 depends from claim 12 and recites "wherein the risk evaluator computes the cost of the mortgage insurance and then discounts the computed cost by taking into account a reduced likelihood of default on the mortgage due to the job loss component" as described at p. 6, lines 9-14; and p. 14, line 20-p. 15, line 2, for example.

Claim 22

Claim 22 depends from claim 21 and recites "wherein the discounted cost of the mortgage insurance component is combined with the cost of the job loss component to determine the overall cost of the package" as described at p. 6, line 15-p. 7, line 4; and p. 15, lines 1 and 2, for example.

Claim 23

Claim 23 depends from claim 22 and recites "wherein the risk evaluator further comprises an optimization module to make modifications to various parameters of the package and examine the effects of the modifications on overall cost of the package", such as optimization module 306 of Fig. 3, described at p. 15, line 3-p. 17, line 6.

Claim 24

Claim 24 depends from claim 22 and further comprises "a package terms development module to generate a set of documents which may be included in a loan package", such as package terms development module 218 of Fig. 2, described at p. 16, lines 7-14; p. 17, line 13-p. 18, line 2; and p. 20, lines 20 and 21, for example.

6. Grounds of Rejection to be Reviewed on Appeal

Claims 5-13 and 20-24 stand rejected under 35 U.S.C. § 101 as directed to non-statutory matter. Claims 5-20 stand rejected under 35 U.S.C. 103(a) over Flagg U.S. Patent No. 6,456,979 (Flagg) in view of Libman U.S. Patent No. 6,999,938 further in view of Debber U.S. Published Patent Application No. 2003/0144887 (Debber) (while paragraph 12 of the Office Action indicates claims 5-24 are rejected on these items, it appears 21-24 are actually rejected based on these items plus Tyler). Claims 21-24 stand rejected under 35 U.S.C. 103(a) over Flagg in view of Libman in view of Debber in further view of Tyler U.S. Patent No. 5,523,942 (Tyler) (from paragraph 23, it is clear claim 22 which depends on claim 21 is also rejected on these four items, and as claims 23 and 24 depend on claim 22, they must be as well).

7. Argument

A. Section 101 Rejection

Claims 5-13 and 20-24 were rejected under 35 U.S.C. § 101 as directed to "a system which comprises storage hosting a risk data repository, and insurance data repository and a risk evaluator. The storage and repositories constitute data and the risk evaluator is a software module. Hence, claim 5 is directed to non-patent eligible statutory matter. Claims 6-13 and 20-24, as dependents of claim 5, are also rejected under the same analysis." Final Official Action, page 5, paragraph 10.

With respect to claim 5, that claim addresses a "computer implemented system" and it is not necessary to go further to conclude that this claim addresses a "machine" clearly within the terms of Section 101. However, the claim additionally recites "long term storage". While data is stored, the storage is memory and not merely data. The claim further recites "a risk evaluator implemented as a software module hosted by **the computer** and executed under control of **a processor** to determine risks and costs associated with providing insurance". Finally, the risk evaluator, software executed under control of a processor, further operates "to compute overall risk and cost . . . and adjust parameters . . . to optimize the risk and cost of the package." In short, the claim addresses a classic computer implemented system and not simply data and not simply software. Such systems clearly are recognized as statutory.

With respect to dependent claims 6-13 and 20-24, these claims stand rejected along with claim 5. The lack of further analysis as to these claims is fatal, and the rejection of these claims under Section 101 must be withdrawn. Unlike a Section 112 problem that will infect or attach to all dependent claims, Section 101 does not work like that. A non-statutory independent claim can be made statutory by the additional recital of statutory subject matter in the claimed

combination of the dependent claim. Thus, dependent claims **must be** considered separately and as a whole with respect to the entirety of their subject matter. In this regard, claim 6 recites "a package timing development module", claim 7 recites "an operator interface module allowing submission of criteria", claim 8 recites "a consumer interface module allowing submission by a consumer". In claim 12, "the computer implemented system receives inquiries and commands from external computers" and so on. Each of these further elements further establish the statutory nature of the claimed subject matter.

B. Rejection under 35 U.S.C. § 103(a) over Flagg, Debber and Libman

The reliance upon Flagg, Debber and Libman is misplaced. As addressed in greater detail below, Flagg addresses arrangements for "evaluating permanent life insurance policies". It does not address "mortgage insurance" or "packages including a combination of a mortgage insurance component and at least one additional insurance component **having an effect on the risk of the mortgage insurance component when sold together with the mortgage insurance component**" as claimed by claim 5, for example. (emphasis added) These are two substantial failings for the main reference. While Libman does address mortgage insurance peripherally, none of these items address the specifically claimed packages, nor do they teach the tools needed to assemble and market such packages in the manner claimed as addressed further below.

Claims 5-20

The art rejections of these claims are based upon Flagg in view of Debber in further view of Libman. Flagg, Debber and Libman do not support the rejections based thereon. Flagg is entitled "Method of Evaluating a Permanent Life Insurance Policy". In the context of permanent life insurance, his Abstract addresses a "matrix of mortality profiling" which "may include gender-based, lifestyle and pricing method risk values". More specifically, Flagg addresses a

method for "evaluating permanent life insurance policies for cost and performance criteria." Flagg, col. 1, lines 7 and 8. It does not address "mortgage insurance" or "packages including a combination of a mortgage insurance component and at least one additional insurance component having an effect on the risk of the mortgage insurance component when sold together with the mortgage insurance component" as claimed by claim 5. At page 6, toward the end of paragraph 13, the final Official Action appears to admit as much stating: " Flagg and Debber do not disclose the insurance data repository including information about a mortgage insurance component and additional insurance components" relying on Libman at Fig. 9, col. 14, lines 23-27.

Consequently, the final Official Action effectively admits Flagg fails to teach any elements of claim 5 as "the risk information" in the "risk data repository" is "used in determining the risk and cost of providing insurance packages" where those packages include a combination of components admittedly absent from Flagg and Debber. Similarly, the "insurance data repository" of claim 5 includes "information about the mortgage insurance component and the one or more additional components". In this regard, Flagg is again silent as it only appears to address permanent life insurance. The "risk evaluator" of claim 5 adjusts "the cost of the mortgage insurance component in light of the effect on said risk of the at least one additional component". Flagg is again silent.

Debber par. [0073] is cited as describing "a system comprising a risk data repository and a risk evaluator". However, the only mention of "risk" in par. [0074] of Debber is his recitation of "risk query module 408" and "risk database interface module 410". By contrast, claim 5 specifically recites "a risk evaluator for determining risks and costs associated with providing insurance, the risk evaluator being operative to compute overall risk and cost for the combined

package and adjust parameters of the package components including adjusting the cost of the mortgage insurance component in light of the effect on said risk of the at least one additional insurance component to optimize the risk and cost of the package." The recitation found in Debber par. [0074] clearly does not teach and does not make obvious the "risk evaluator" claimed by claim 5. A review of the remainder of Debber establishes that while paras. [0041], [0063], [0072-0079], [0091] and [0094] address aspects of his treatment of risk information, their teaching is very general such as retrieve "risk data corresponding to the application data". Consequently, Debber as a whole does not teach and does not make obvious the claimed "risk evaluator".

Debber is entitled "System and Method for Electronically Creating, Filing and Approving Applications for Insurance Coverage". The Debber approach focuses on generating "one or more applications and automatically "submitting" them to respective insurer systems". Debber, Abstract. As such it mainly focuses on electronically creating, filing and approving insurance applications. As correctly admitted by the final Official Action, Debber has no specific teaching relating to packages of insurance comprising two or more components including a mortgage insurance component, or the importance of the evaluation of the effect upon the mortgage insurance component made by an additional component, such as the job loss component or insurance of dependent claims 10-13, independent claim 14 and its dependent claims 15-18, independent claim 19, and dependent claims 20-24. Dependent claims 21-24 are also addressed further separately below.

In analyzing claim 5, the Official Action states "Libman does" disclose the insurance data repository including information about a mortgage insurance component and additional insurance components citing Libman Fig. 9 and col. 14, lines 23-27 further stating it "would

have been obvious" to "combine the teachings of Flagg, Debber and Libman to include data about mortgage insurance and insurance packages in order to market bundled products to consumers with more than one type of insurance need." With respect to claim 10, the Official Action states "A predictable result of Debber and Libman would be to provide as many types of insurance packages as possible to clients in order to offer them better, more customized products to meet their needs at competitive prices (KSR International Co. v. Telefax Inc., 82 USPQ 2d 1385 (US 2007))."

This conclusory analysis is traversed as legally incorrect and factually unsupported. The key to supporting any prima facie conclusion of obviousness under 35 U.S.C. 103 is the clear articulation of the reason or reasons why the claimed invention would be obvious. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be implicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements". In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006) (quoted with approval by KSR).

Libman provides no basis for modifying Flagg and Debber to rectify their currently admitted failings as references. Libman addresses an "Automated Reply Generator Direct Marketing System" for "automatically preparing customized replies in response to a plurality of clients". Libman, Title and Abstract. As such, it is primarily focused on mass mailings, emailings or other potential contacts with possible customers and the handling of replies therefrom. In this context, at col. 6, lines 56-65, Libman states "Financial Product" as the term is used herein is used in its broad sense to include any financially-related product, service or plan. The term would include, for example, insurance products and services, banking products and services, securities and investment products and services, and the like. Examples of insurance

products would include individual life insurance of all types, tax deferred annuities of all types, health insurance of all types, disability insurance of all types, annuities or other payment vehicles." The text at col. 14, lines 15-30 is similarly broad brush and says specifically at lines 24-27 "Where combinations of insurance products are included, they may include, for example, a combination of an individual term life insurance product and an individual permanent life insurance product." No other examples of combined insurance offerings are given, and there is no specific teaching of mortgage insurance in combination with any other insurance, and in particular, **there is no teaching of job loss insurance.**

Thus, even if a combination of individual term life insurance and individual permanent life insurance is somehow imported from Libman to Debber, such a package does not make the present claims obvious. In this regard, it is noted that claim 5 recites "a risk evaluator . . . to . . . adjust parameters of the package components including **adjusting the cost of the mortgage insurance component in light of the effect on said risk of the at least one additional component**", and the remaining independent claims address optimizing the package in a manner not addressed by Debber and Libman individually, and not obvious from the two items taken in combination.

The present invention as claimed by claims 5, 14 and 19 addresses "insurance packages including a combination of a mortgage insurance component having a risk when sold separately and at least one additional component having an effect on the risk of the mortgage insurance when sold together with the mortgage insurance component" (claim 5) and "combined packages including mortgage insurance and job loss insurance" (claims 14 and 19). Dependent claim 10 specifically recites "job loss insurance". While applicants do not acquiesce in the Examiner's apparent suggestion that it is obvious to package as many different kinds of insurance as needed

by a particular customer, that is **NOT** what is claimed here. The present inventors have recognized that certain types of insurance, like job loss insurance, have an effect on the risk of mortgage insurance making a package including both components potentially mutually beneficial. It is clear that other types of insurance such as auto insurance, worker's compensation insurance for a business, an umbrella policy, burial insurance, travel insurance and many other types of insurance available today don't effect risk in a way which would allow one to adjust the cost of the mortgage insurance accordingly. In times, such as the present ones, it is clear the present invention is a worthwhile idea and it is not suggested and is not made obvious by the relied upon art.

Even assuming arguendo that it is obvious to offer up as many packages of different types of insurance as one can dream up, that again is not what is addressed by these claims. The present invention recognizes and the claims address packages where the components have some synergy together going beyond a salesperson's desire to sell as many and as much as possible to everyone. More specifically, claim 5 recites "the risk evaluator operating to compute overall risk and cost for a combined package and adjust parameters of the package components including **adjusting the cost of the mortgage insurance component in light of the effect on said risk of the at least one additional component to optimize the risk and cost of the package.**" (emphasis added)

Finally, in paragraph 18 at the bottom of page 7, the final Official Action in its analysis of claim 10 states "Furthermore, the type of insurance package is non-functional descriptive material that does not further limit the system of claim 5". Claim 10 as a dependent claim includes all of the limitations of the claims from which it depends. Claim 10 clearly does further limit claim 5. The "long term storage hosting a risk data repository for storing risk information

to be used in determining the risk and cost of providing insurance packages" is changed to store "job loss insurance" data. With this data, it's a different database. Without this different database, the system cannot function to evaluate job loss insurance. Similarly, the "risk evaluation" also necessarily changes. The software, for example, changes or the evaluator won't work to evaluate job loss insurance and mortgage insurance packages as claimed. Finally, and dispositively, claim 10 specifically spells out that "the additional insurance components whose information is stored in the insurance data repository **include job loss** components". A new system or machine clearly results. The cited non-functional descriptive material cases are clearly not applicable here.

C. Rejection under 35 U.S.C. § 103(a) over Flagg, Debber, Libman and Tyler

The further reliance upon Tyler in addition to the previously addressed items is misplaced.

Claims 21-24

These claims are rejected based on Flagg, Debber, Libman and Tyler. In paragraph 23, the final Official Action correctly admits "Flagg, Debber and Libman do not specifically recite discounting the computed cost by taking into account a reduced likelihood of default on the mortgage due to the job loss component." Since, Flagg, Debber and Libman do not disclose packages of mortgage insurance and job loss insurance, it would be impossible for them to do so. Does the final Official Action then cite a reference addressing "discounting the computed cost by taking into account a reduced likelihood of default due to the job loss component"? No, to the contrary, it relies on Tyler which it characterizes as disclosing "reducing policy costs based on certain parameters or clients' potential circumstances, such as early payments (Col. 33 lines 66-67, col. 7, line 1)."

At col. 7, line 1, Tyler simply says "For example, if the design grid is controlled by and dis-". The text continues: "played on the screen of a laptop computer, then the calculation engine can be controlled by the same laptop computer." This text has no apparent immediate relationship to the point sought to be established by the final Official Action. At col. 33, lines 66 and 67 (and continuing to the period at the top of col. 34) Tyler reads "Discounted Premium - A discount is given for early payment of premiums and up to twenty premiums may be discounted." Quite simply, this sentence does not match up with its characterization in the final Official Action. No teaching is found in the cited text relating to reducing the cost of one component of a package, mortgage insurance, based upon the impact thereon of another component of the package, job loss insurance. The relied upon portion of Tyler would simply appear to suggest that the cost of insurance like life insurance with annual or otherwise scheduled premiums could be reduced for early payment.

D. The Examiner's Findings of Obviousness are Also Contrary to Law of the Federal Circuit

As shown above, the invention claimed is not taught and not suggested by the relied upon prior art. The references cited by the Examiner, if anything, teach away from the present invention. It is only in hindsight, after seeing the claimed invention, that the Examiner could combine the references as the Examiner has done. This approach is improper under the law of the Federal Circuit, which has stated that "[w]hen prior art references require selective combination by the Court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 U.S.P.Q. 2d 1434, 1438 (Fed. Cir. 1988), cert. den., 109 S. Ct. 75, 102 L.Ed. 2d 51 (1988); quoting Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1132, 227 U.S.P.Q. 543, 535 (Fed. Cir. 1985). Furthermore, "[i]t is impermissible to

use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention." Uniroyal, 837 F.2d at 1051, 5 U.S.P.Q. 2d at 1438.

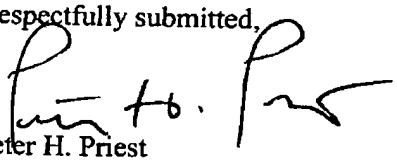
In addition, the Examiner does not appear to have considered "where the references diverge and teach away from the claimed invention", Akzo N.V. v. International Trade Commission, 808 F.2d 1471, 1481, 1 U.S.P.Q. 2d 1241, 1246 (Fed. Cir. 1986), cert. den., 107 S. Ct. 2490, 482 U.S. 909, 107 S.Ct. 2490 (1987); and W.L. Gore Associates, Inc., 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983); nor has the Examiner read the claims as a whole, as required by statute. 35 U.S.C. §103. See also, Smithkline Diagnostics Inc. v. Helena Laboratories Corp., 859 F.2d 878, 885, 8 U.S.P.Q. 2d 1468, 1475 (Fed. Cir. 1988); and Interconnect Planning Corp., 774 F.2d at 1143, 227 U.S.P.Q. at 551.

The Examiner's rejection suggests that the Examiner did not consider and appreciate the claims as a whole. The claims disclose a unique combination with many features and advantages not shown in the art. It appears that the Examiner has oversimplified the claims and then searched the prior art for the constituent parts. Even with the claims as a guide, however, the Examiner did not recreate the claimed invention.

8. Conclusion

The rejection of claims 1-20 should be reversed and the application promptly allowed.

Respectfully submitted,



Peter H. Priest
Reg. No. 30,210
Priest & Goldstein, PLLC
5015 Southpark Drive, Suite 230
Durham, NC 27713
(919) 806-1600

CLAIMS APPENDIX
(Claims Under Appeal)

5. A computer implemented system for assembling and marketing insurance packages including a combination of a mortgage insurance component having a risk when sold separately and at least one additional insurance component having an effect on the risk of the mortgage insurance component when sold together with the mortgage insurance component, comprising:

long term storage hosting a risk data repository for storing risk information to be used in determining the risk and cost of providing insurance packages;

the long term storage further hosting an insurance data repository including information about one or more available additional insurance components, the repository including information about the mortgage insurance component and the one or more additional insurance components; and

a risk evaluator implemented as a software module hosted by the computer and executed under control of a processor to determine risks and costs associated with providing insurance, the risk evaluator operating to compute overall risk and cost for a combined package and adjust parameters of the package components including adjusting the cost of the mortgage insurance component in light of the effect on said risk of the at least one additional component to optimize the risk and cost of the package.

6. The system of claim 5, further including a package terms development module for receiving desired criteria for an insurance package and developing a set of terms meeting those criteria and wherein the package terms development module passes the desired criteria to the risk evaluator and the risk evaluator produces optimized risk and cost information for a package

meeting the desired criteria.

7. The system of claim 6, further comprising an operator interface module allowing submission of criteria to be used in developing insurance packages to be made available and wherein terms meeting the criteria are presented to an operator using the operator interface module.

8. The system of claim 7, further comprising a consumer interface module allowing submission by a consumer of criteria for a specific insurance package and wherein terms meeting the criteria are presented to the consumer using the consumer interface module.

9. The system of claim 8, further including a package negotiation module operative to receive an indication from a consumer to commit to coverage and to assemble and store details of the coverage package and the commitment for coverage.

10. The system of claim 9, wherein the insurance packages assembled and marketed include a combination of mortgage insurance and job loss insurance, and wherein the additional insurance components whose information is stored in the insurance data repository include job loss components.

11. The system of claim 10, wherein the package terms development module, the operating interface module, the customer interface module, and the package negotiation module are implemented in the form of software hosted on the computer implemented system executed under control of the processor.

12. The system of claim 11, wherein the computer implemented system receives inquiries and commands from external computers over a publicly accessible network and transfers information to the external computers over the publicly accessible network.

13. The system of claim 12, wherein the publicly accessible network is the Internet.

14. A computer based method of developing and marketing combined packages of insurance including mortgage insurance and job loss insurance, comprising the steps of:

collecting and storing data related to risks and costs of providing insurance in a data repository hosted in long term storage;

developing utilizing a processor executing software details of insurance components in long term storage, said components to be made available in the form of combined packages, the packages including a mortgage insurance component and a job loss insurance component;

storing said details; and

evaluating risks and costs associated with providing a package of insurance including mortgage insurance and job loss insurance employing a risk evaluator implemented as a software module executed under control of the processor, evaluation comprising evaluating each component of the package, and evaluating the combined risk and cost of the package as a whole; and

adjusting parameters of the package to optimize the risk and cost of the package utilizing an optimization module implemented as a software module executed under control of the processor.

15. The method of claim 14, further including receiving a set of criteria for an insurance package, and computing optimized risk and cost information to develop an optimized set of cost information and package parameters for a package meeting the criteria.

16. The method of claim 15, wherein the step of receiving the set of criteria comprises receiving a set of criteria for an insurance package required by a consumer and further comprising a step of providing the consumer with cost information and package parameters for a package meeting the criteria.

17. The method of claim 16, wherein the step of receiving a set of criteria for an insurance package includes receiving the criteria as electronic data transferred over a computer network and the step of computing optimized risk and cost information includes retrieving risk and cost information stored in an electronic database and performing electronic data processing on the criteria for the insurance package and on the risk and cost information to develop an optimized set of parameters for the insurance package.

18. The method of claim 17, wherein the step of receiving the set of criteria for an insurance package includes presenting hypertext forms for display on a customer computer and receiving a submission of information entered using the hypertext forms.

19. A computer readable medium storing a software program which when executed on a computer is operative to:

receive and store data related to risks and costs of providing insurance;

store details of insurance components to be made available in the form of combined packages, the packages including a mortgage insurance component and a job loss insurance component; and

evaluate risks and costs associated with providing a package of insurance including mortgage insurance and job loss insurance, evaluation comprising evaluating each component of the package, evaluating the combined risk and cost of the package as a whole and adjusting parameters of the package to optimize the risk and cost of the package.

20. The system of claim 5 wherein the combined package comprises a job loss component having a cost.

21. The system of claim 20 wherein the risk evaluator computes the cost of the mortgage insurance and then discounts the computed cost by taking into account a reduced

likelihood of default on the mortgage due to the job loss component.

22. The system of claim 21 wherein the discounted cost of the mortgage insurance component is combined with the cost of the job loss component to determine the overall cost of the package.

23. The system of claim 22 wherein the risk evaluator further comprises an optimization module to make modifications to various parameters of the package and examine the effects of the modifications on overall cost of the package.

24. The system of claim 22 further comprising:

a package terms development module to generate a set of documents which may be included in a loan package.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.